

Remarks

Claim Rejections Under 35 USC 102

Claims 1-11, 14, and 16-24 are rejected under 35 USC 102 as being unpatentable over US Patent 6,130,666 to Persidsky.

Effective Dates

The US patent of Persidsky was granted on October 10, 2000, which is after the international application date (November 19, 1999) of Applicant's pending Patent Application. Therefore, Persidsky should not be considered as a prior publication.

Consequently, we respectfully disagree with the rejection under 35 USC 102(b) in view of Persidsky.

Novelty

However, if the patent of Persidsky should be taken into consideration under 35 USC 102 it is respectfully submitted, that Persidsky does not describe the same invention as presently claimed.

Valid rejection under 35 USC 102 requires that each feature of a rejected claim be disclosed in a single reference. "For anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP 706.02(a)

Persidsky does not disclose each feature of the rejected claims. Persidsky describes a self-contained pen computer with built-in display, comprising a motion sensor which outputs signals describing the motion of the pen, so that hand-written data can be acquired without the need for a special writing surface.

The pen of Persidsky processes digital movement signals to determine the distance and direction. This is done to reconstruct the image of the path of the writing tip (see col. 4, lines 4 to 15).

Consequently, Persidsky teaches processing and storing the relative movement of the writing tip or the pen. But no absolute position determination of the pen is provided or mentioned.

In contradiction thereto, a feature of the present invention is that the inventor has recognized that the absence of checking of the absolute stylus position during the writing operation is particularly disadvantageous (see page 2, lines 30 to 33 of the present invention).

That disadvantage applies to the pen of Persidsky.

To overcome that disadvantage the present invention determines the absolute position or, in other words, the position associated with the information in addition to the relative position (see page 3, lines 27 to 29 of the present specification).

Moreover, to even more clearly distinguish the present claims, the wording of claims 1 and 21 is clarified according to the enclosed amended claims.

Amended claim 1 clearly defines an apparatus comprising a writing instrument and a writing pad for recording a data record, wherein said data record contains data corresponding to information on the writing pad and

positions on the writing pad, said positions being associated with the information.

Persidsky merely detects the information, but does not disclose recording of positions being associated with the information.

Therefore, subject matter of present claim 1 distinguishes at least by the aforementioned feature from the teaching of Persidsky.

The same applies for amended claim 21, which is also clarified in the same way.

Therefore, it is respectfully submitted, that Persidsky does not anticipate the claimed subject matter.

Claim Rejections Under 35 USC 103

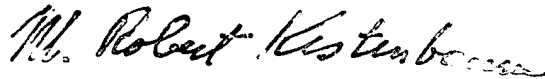
Claims 12, 13, and 15 are rejected under 35 USC 103(a) as being obvious over Persidsky in view of Lewis et al. '792.

Since Applicant respectfully believes that the present application is patentable over Persidsky, the above-mentioned rejections under 35 USC 103 do not apply.

Wherefore, further consideration and allowance of the claims is respectfully requested.

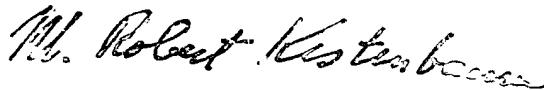
A one-month extension of time in which to respond to the outstanding Office Action is respectfully requested. PTO Form 2038 is included herewith authorizing charging the credit card for the appropriate Small Entity extension fee of \$55. Please charge deposit account 11-0665 for any additional fees or for crediting any refunds. A duplicate of this page is included for this purpose.

Respectfully submitted,



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I hereby certify this correspondence is being deposited with the US Postal Service as first class mail in an envelope with adequate postage addressed to Mail Stop Amendment with Fee, Commissioner for Patents, PO Box 1450, Alexandria, Va. 22313-1450 on August 25, 2003.



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